

REMARKS

Claims 1-10 are pending in this application. Claims 1, 9 and 10 are independent claims. By this amendment, claims 1, 9 and 10 are amended.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

The Claims Define Patentable Subject Matter

The Office Action makes the following rejections: (1) claims 1, 2, 4-7, 9 and 10 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,476,869 to Sekine et al. (hereafter Sekine); and (2) claims 3 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sekine.

These rejections are respectfully traversed.

102(e) Rejection

Applicant respectfully submits that Sekine fails to teach or suggest each and every feature as set forth in the claimed invention.

The Office Action alleges that Sekine discloses an image memory (video tape) for storing the digital image data (color video output) and a lens characteristic (aberration information code) relating to the image forming lens (zoom lens 12). (see Office Action, page 2). In other words, the Examiner is associating Sekine's video tape with the claimed image memory and Sekine's aberration information code with the claimed lens characteristic.

Furthermore, the Examiner alleges that Sekine discloses a lens characteristic correction unit in Fig. 2.

However, in contrast with the present invention, Sekine merely discloses in Fig. 2 a system for reproducing and aberration-correcting the information on the video tape, including a reproduction circuit 36, a computing circuit 40 and an image memory 38. (see Sekine, Fig. 2 and col. 4, lines 1-12). In other words, Sekine discloses that its reproducing and aberration-correcting system (as shown in Fig. 2) is a separate unit from the video camera shown in Sekine's Fig. 1. (see Sekine, col. 4, lines 57-66).

As such, Sekine's purpose is to design a video camera that is small in size and light in weight, therefore, the computing unit 40 and the image memory 38 are configured in a separate apparatus wherein aberration correction can not be carried out before the shooting of a next frame of an image nor during the shooting of the next frame onward, as set forth in the amended claims. (see Sekine, col. 4, line 57 to col. 5, line 2).

Further evidence of Sekine's purpose of having separate apparatus for recording and correcting the image data is shown in col. 5, wherein Sekine discloses that the image and the aberration information are arranged to be transmitted by means of a video tape to the remote correcting unit. In addition, Sekine expressly discloses that the aberration correction is not performed on the side of the camera. (see Sekine, col. 5, lines 29-30).

As such, we believe the present invention is at least distinguishable from Sekine because in the present invention the digital image shooting device includes means for both producing and

correcting the image aberrations before the shooting of a next frame of an image or during the shooting of the next frame onward. Instead, Sekine must transmit a series of stored image and aberration data to a separate location for processing.

According to MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). The elements must be arranged as required by the claims, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicant respectfully submits that the Office Action has failed to establish the required *prima facie* case of anticipation because the cited reference, Sekine, fails to teach or suggest each and every feature as set forth in the claimed invention.

Applicant respectfully submits that independent claims 1, 9 and 10 are allowable over Sekine for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1, 2, 4-7, 9 and 10 under 35 U.S.C. §102(e) is respectfully solicited.

103(a) Rejection

Applicant also respectfully submits that Sekine fails to make obvious the claimed invention as set forth in claims 3 and 8.

In addition to the reasons noted above, applicant respectfully submits that Sekine fails to make obvious the claimed invention as set forth in dependent claims 3 and 8 because the Examiner is merely relying on hindsight to suggest that it would have been obvious to perform correction of the aberration before a process of compressing the digital image data. As conceded by the Examiner, Sekine is completely silent about the compressing process.

As such, applicant submits that the Examiner is merely overreaching in his Official Notice of the data compression process. Just because there are known advantages of compressing image data doesn't lead one to be motivated to correct an aberration prior to performing such a compression process.

For at least this reason, applicant respectfully requests that the Examiner specifically illustrate to applicant such a "prior to compressing" feature with a specific cited reference. Otherwise, such a rejection should be withdrawn.

Furthermore, the Examiner alleges that it would have been obvious to include a plurality of image forming lenses and a plurality of lens characteristics in the system of Sekine without providing a clear motivation to do so. As such, as noted above, applicant submits that the Examiner is using impermissible

hindsight reconstruction to arrive at the claimed invention. Sekine is completely silent about a plurality of lenses being used or a plurality of associated lens characteristics related thereto being stored.

In summary, applicant respectfully submits that the Examiner's allegations under §103(a) clearly lacks motivation for modifying Sekine to have the above noted features and are merely premised on impermissible hindsight.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that not only does Sekine fail to teach or suggest each and every feature as set forth in the claimed invention, but that one of ordinary skill in the art would not have been motivated to modify the teachings of Sekine because there is no teaching or suggestion in Sekine regarding how or why one would modify such systems to arrive at the claimed invention.

Applicant respectfully submits that dependent claims 3 and 8 are allowable over Sekine for at least the reasons noted above.

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Accordingly, withdrawal of the rejection of claims 3 and 8 under 35 U.S.C. §103(a) is respectfully requested.

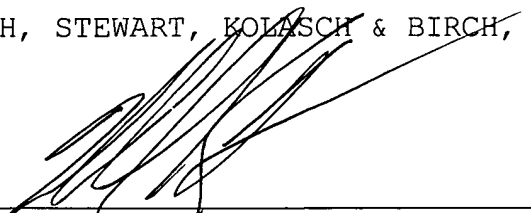
Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 to schedule a Personal Interview.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Respectfully submitted,
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